UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,370	10/21/2003	Matthew T. Adams	13560	7689

7590 11/08/2005

ORUM & ROTH
53 W. JACKSON BLVD
CHICAGO, IL 60604

EXAMINER	
MAYES, MELVIN C	
ART UNIT	PAPER NUMBER
1734	

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,370	ADAMS ET AL.	
	Examiner	Art Unit	
	Melvin Curtis Mayes	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-14 and 20-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-14 and 20-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

(1)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(2)

Claims 11-13, 20, 24-26, 28, 32 and 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 18 of copending Application No. 10/689,941 in view of Bianco 4,891,254 and either Iriyama 2001/0019761 or Gupta 4,891,504.

Copending Application No. 10/696,941 claims a method of labeling a composite material comprising: obtaining a porous mesh carrier; printing ink indicia on the carrier; and embedding the carrier in a composite material, further comprising placing the printed carrier on the surface of the composite; coating the carrier with resin; and allowing the resin to flow into the mesh. Copending Application No. 10/696,941 does not claim printing with magnetically-doped ink, ink with UV components or ink with IR components.

Bianco teaches that in embedding identification means in a composite article by placing the printed carrier on a fiberglass base and coating with a layer of epoxy or polyester material so that the carrier becomes an integral part of the fiberglass article, the carrier can be printed with a bar code to be read by other than visually, say with infrared light for example (col. 3, lines 4-18).

Iriyama teaches that invisible patterns include patterns formed by printing using a fluorescent ink that is transparent to visible light and emits fluorescent light when irradiated with ultraviolet rays, or bar codes or identification marks formed by printing using infrared absorption ink or magnetic ink [0084].

Gupta teaches that bar codes or non-human perceptible markings are provided by magnetic or UV/IR sensitive inks with appropriate detectors (col. 2, lines 42-45).
It would have been obvious to one of ordinary skill in the art to have modified the method of copending Application No. 10/689,941 for labeling a composite material by printing the carrier with either magnetic ink or ink that is readable by UV or infrared light, as Bianco teaches that a composite article is provided with identification means in the form of a bar code that can be read other than visually, such as by infrared light, and Iriyama or Gupta teach that bar codes can be provided by magnetic ink or UV or IR sensitive inks. The use of either of magnetic ink, UV ink or IR ink for printing bar codes readable other than by visually would have been obvious to one of ordinary skill in the art as known alternative inks for providing bar codes to be read, as taught by Iriyama or Gupta.

This is a provisional obviousness-type double patenting rejection.

(3)

Claims 24-26, 28, 32 and 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 18 of copending Application No. 10/689,941 in view of Bianco 4,891,254 and Outwater 6,612,494.

Copending Application No. 10/696,941 claims a method of labeling a composite material comprising: obtaining a porous mesh carrier; printing ink indicia on the carrier; and embedding the carrier in a composite material, further comprising placing the printed carrier on the surface of the composite; coating the carrier with resin; and allowing the resin to flow into the mesh. Copending Application No. 10/696,941 does not claim printing with ink with either UV or IR components.

Bianco teaches that in embedding identification means in a composite article by placing the printed carrier on a fiberglass base and coating with a layer of epoxy or polyester material so that the carrier becomes an integral part of the fiberglass article, the carrier can be printed with a bar code readable by other than visually, for example with infrared light (col. 3, lines 4-14).

Outwater teaches that an object can be identified with a bar code for authentification by marking the object with a marker which fluoresces when illuminated with one of UV and IR but not when illuminated with visible light (Abstract).

It would have been obvious to one of ordinary skill in the art to have modified the method of copending Application No. 10/689,941 for labeling a composite material by printing the carrier with ink that is readable either by UV or IR light, as taught by Bianco, to provide a composite article with identification means in the form of a bar code readable by other than visually, and, as taught by Outwater, as ink used to provide bar code markers for objects so as to

fluoresce when illuminated by either UV or IR light. Providing the printing ink with either UV or IR components would have been obvious to one of ordinary skill in the art to allow the bar code indicia to be visible only when illuminated by UV or IR light, as taught by Outwater.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

(4)

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(5)

Claims 24-26, 28, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco 4,891,254 in view of Outwater 6,612,494.

Bianco discloses a method of embedding identification means in an article comprising: providing a carrier substrate with readable information; placing the carrier substrate on a base such as fiberglass; and coating the carrier substrate and base with a layer of epoxy or polyester material so that the substrate becomes an integral part of the fiberglass article. The carrier substrate can be any suitable material known in the art which will not undesirably react with the embedding material. The identification means on the carrier substrate can be a bar code that is readable other than visually, such as with infrared light for example.

Outwater teaches that an object can be identified with a bar code for authentification by marking the object with a marker which fluoresces when illuminated with one of UV and IR but not when illuminated with visible light.

It would have been obvious to one of ordinary skill in the art to have provided the carrier substrate with a bar code readable by either UV or IR light, as Outwater teaches that bar code for authentification can be provided by a marker which fluoresces when illuminated by UV or IR light. The use of ink with either UV or IR components would have been obvious to one of ordinary skill in the art to allow the bar code to be read only when illuminated by UV or IR light, as taught by Outwater.

Providing the carrier substrate of suitable material such as paper, into which the epoxy or polyester can flow, or resin sheet, as claimed in Claims 12 and 13, would have been obvious to one of ordinary skill in the art, as Bianco discloses that the carrier substrate can be any suitable material known in the art which will not undesirably react with the embedding material.

(6)

Claims 27, 29-31, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco 4,891,254 in view of Outwater 6,612,494 as applied to claims 24, 25, 26, 28, 32 and 33, and further in view of Taggart 2003/0217802.

Taggart teaches that in making automotive structures from composite blanks, the blanks are properly identified using inkjet and/or bar code tracking technology [0060].

It would have been obvious to one of ordinary skill in the art to have used the method of the references as combined to provide bar code identification on composite automotive components, as taught by Taggart, to properly identify composite blanks for making automotive structures. The use of the method of the references as combined to make bar codes integral with

automotive composite components would have been obvious to one of ordinary skill in the art to provide identification for making automotive structures from the components, as suggested by Taggart.

(7)

Claims 11-13, 20, 24-26, 28, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco 4,891,254 in view of either Iriyama 2001/0019761 or Gupta 4,891,504.

Bianco discloses a method of embedding identification means in an article comprising: providing a carrier substrate with readable information; placing the carrier substrate on a base such as fiberglass; and coating the carrier substrate and base with a layer of epoxy or polyester material so that the substrate becomes an integral part of the fiberglass article. The carrier substrate can be any suitable material known in the art which will not undesirably react with the embedding material. The identification means on the carrier substrate can be a bar code that is readable other than visually, such as with infrared light for example. Bianco does not disclose printing the bar code with magnetically-doped ink or ink with UV components.

Iriyama teaches that invisible patterns include patterns formed by printing using a fluorescent ink that is transparent to visible light and emits fluorescent light when irradiated with ultraviolet rays, or bar codes or identification marks formed by printing using infrared absorption ink or magnetic ink [0084].

Gupta teaches that bar codes or non-human perceptible markings are provided by magnetic or UV/IR sensitive inks with appropriate detectors (col. 2, lines 42-45).

It would have been obvious to one of ordinary skill in the art to have modified the method of Bianco for embedding identification means in an article by printing the carrier with a

bar code of either magnetic ink or ink that is readable by UV or infrared light, as Bianco discloses that the article is provided with identification means in the form of a bar code that can be read other than visually, such as by infrared light, and Iriyama or Gupta teach that bar codes can be provided by magnetic ink or UV or IR sensitive inks. The use of either of magnetic ink, UV ink or IR ink for printing bar codes readable other than by visually would have been obvious to one of ordinary skill in the art as known alternative inks for providing bar codes to be read, as taught by Iriyama or Gupta.

Providing the carrier substrate of suitable porous material such as paper, into which the epoxy or polyester can flow, or resin sheet, as claimed in Claims 12 and 13, would have been obvious to one of ordinary skill in the art, as Bianco discloses that the carrier substrate can be any suitable material known in the art which will not undesirably react with the embedding material.

(8)

Claims 21-23, 27, 29-31, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco 4,891,254 in view of either Iriyama 2001/0019761 or Gupta 4,891,504 as applied to claims 12, 13 ,20, 24, 25, 26, 28, 32 and 33, and further in view of Taggart 2003/0217802.

Taggart teaches that in making automotive structures from composite blanks, the blanks are properly identified using inkjet and/or bar code tracking technology [0060].

It would have been obvious to one of ordinary skill in the art to have used the method of the references as combined to provide bar code identification on composite automotive

components, as taught by Taggart, to properly identify composite blanks for making automotive structures. The use of the method of the references as combined to make bar codes integral with automotive composite components would have been obvious to one of ordinary skill in the art to provide identification for making automotive structures from the components, as suggested by Taggart.

Response to Arguments

(9)

Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive.

Applicant argues that Bianco does not disclose or suggest using magnetically-doped ink but teaches using visible markers that can be read with infrared light.

(10)

Bianco sets forth the use of infrared light only as an example of a method by which a bar code can be read other than visually. Thus the reference is not limited to only using bar codes that can be read by IR. This is reflected in the fact that for higher temperature uses, Bianco suggests using bar code formed of iron powder. The Examiner's position is that the use of any of magnetic ink, UV ink or IR ink would have been obvious to one of ordinary skill to provide a bar code that can be read other than visually, as suggested by the cited references.

Conclusion

(11)

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

(12)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM
November 4, 2005